

### **REMARKS**

The Office Action dated December 15, 2004, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claims 1, 3, 7, 9, 15, 16 and 26 are amended and claims 6 and 8 are cancelled. No new matter has been added. Claim 28 was withdrawn pursuant to an Election of Species Requirement dated August 11, 2004. Claims 1-5, 7, and 9-27 are pending and respectfully submitted for consideration.

The Applicant wishes to thank the Examiner for the interview granted on February 11, 2005. In the interview the Examiner suggested amending the claims to highlight that when a player folds, both antes are forfeited and the player is out of the game. This feature of the invention is disclosed in at least Fig. 5. The Examiner acknowledged that Furuta does not disclose this feature. The Applicant has amended claim 1 accordingly.

Claims 15, 16 and 26 were objected to for minor informalities. The Applicant has amended claims 15, 16 and 26 responsive to the objections and respectfully submits that all claims are in compliance with U.S. patent practice.

Claims 1-8 and 15-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Furuta et al. (U.S. Patent Publication No. US 2003/0094761 A1, "Furuta"). As noted above, claims 6 and 8 have been canceled. Claims 2, 4, 5, and 7 depend either directly or indirectly from claim 1, and claims 17-25 depend from claim 16.

Claims 9-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Furuta in view of Guidi (U.S. Patent No. 5,839,732). Claims 9-14 depend either directly or indirectly from claim 1.

To the extent that the above-noted rejections remain applicable to the claims currently pending, the Applicant respectfully submits that claims 1-5, 7, and 9-27 recite subject matter that is neither disclosed nor suggested by Furuta or Guidi either singly or in combination.

With respect to claim 1, the Applicant submits that Furuta fails to disclose or suggest the claimed features of the invention. Claim 1, as amended, recites receiving a selection from each of the at least one player whether to wager in a first round; taking a first ante from each of the at least one player selecting not to wager in the first round; taking a second ante from each of the at least one player participating in the auxiliary play and selecting not to wager in the first round, and for each of the at least one player that folds, taking the at least one player out of the game. In contrast, Furuta discloses in Fig. 3 that, when the player surrenders the ante (decision block 116), the player can continue play to determine whether the player's hand contains a Royalty Bet (decision clock 118).

Claim 1 also recites that, "if one of the at least one player participating in the auxiliary play was dealt four royal cards of the same suit, awarding a bonus prize to the one of the at least one player participating in the auxiliary play dealt four royal cards of the same suit". As such, in the present invention, the player with four royal cards of the same suit is awarded a bonus prize regardless of the dealer hand, because the player of present invention does not have to beat the dealer to be awarded the bonus prize. In

contrast, the player in Furuta is playing against the dealer hand. As stated in the Abstract of Furuta:

The game is played on a gaming table, with a regular standard deck of cards consisting of 52 cards, and with between one and seven players and a dealer. A hand is dealt for each player and the dealer. Each player is allowed an opportunity to place a bonus bet based on the hand. The hand is then formed into a high hand and a low hand, and a play bet is placed on these two hands. The player's high and low hands are compared to the dealer's high and low hands, respectively, and winners are paid according to a payout schedule. [Emphasis Added].

Accordingly, Furuta does not disclose or suggest that the player with four royal cards of the same suit is awarded a bonus prize regardless of the dealer hand. For at least the combination of reasons the Applicant submits that amended claim 1 is allowable over the cited art.

With respect to amended claims 3, 15, 16, and 26, the Applicant respectfully submits that the patent to Furuta cannot be used to reject these claims, as Furuta is not a proper reference under section of 35 U.S.C. § 102, and therefore, cannot be used to make an obviousness rejection under 35 U.S.C. § 103.

Claims 3, 15, 16, and 26, as amended, recite that the card game is played in accordance with the standard rules of poker using hands of five cards. The Office Action took the position that Furuta discloses a card game is played in accordance with the standard rules of poker. Furuta was filed as a U.S. non-provisional patent application on November 21, 2002, and claims priority to Provisional Application No. 60/332,026, filed on November 21, 2001. The Applicant has reviewed the provisional application of Furuta and submits that there is no disclosure or suggestion of a card game is played in accordance with the standard rules of poker using hands of five

cards, in the provisional application. In the patent to Furuta, subject matter directed to poker was added to the non-provisional application filed on November 21, 2002. Such subject matter is, therefore, not entitled to the provisional application date of November 21, 2001.

The present application was filed on September 11, 2003, and claims priority to Provisional Application No. 60/409,586 filed on September 11, 2002. The subject matter of a card game played in accordance with the standard rules of poker using hands of five cards was disclosed in the Applicant's provisional application. As such, a card game played in accordance with the standard rules of poker using hands of five cards is entitled to the September 11, 2002, priority date. Since poker was disclosed in Furuta on November 21, 2002, which is after the priority date of the present application, Furuta is an improper reference to cite against claims 3, 15, 16, and 26, as amended. Claims 17-25 depend from claim 16 and claim 27 depends from claim 26. Accordingly, the Applicant respectfully requests withdrawal of the rejections of claims 3 and 15-27 in view of the Furuta reference.

Claims 9-14 depend from claim 1 and include all of the features of claim 1. Guidi does not cure the deficiencies in Furuta. Therefore, the Applicant submits that the combination of Furuta and Guidi does not disclose or suggest all of the features of the invention as recited in claims 9-14.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103,

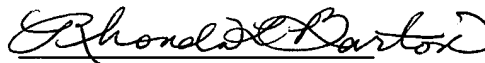
there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure.

In view of the above, the Applicant respectfully submits that Furuta does not disclose or suggest the features of the invention as recited in amended claim 1, and is not a proper reference to apply against claims 3, 15, 16, and 26 of the present application, and the claims dependent therefrom. Also, the combination of Furuta and Guidi does not disclose or suggest the features of the invention as recited in dependent claims 9-14 under 35 U.S.C. § 103. Accordingly, the Applicant respectfully requests allowance of claims 1-5, 7, and 9-27 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 026066-00006.**

Respectfully submitted,



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